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A. Cotton
7-10-02

PATENT
Attorney Docket No. 4967.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Craig D. Ullman et al.

Examiner: Willett, Stephan F.

Serial No. 09/409,305

Art Unit: 2152

Filed: September 29, 1999

For: ENHANCED VIDEO PROGRAMMING
SYSTEM AND METHOD UTILIZING
USER-PROFILE INFORMATION

Commissioner for Patents
Washington, DC 20231

REQUEST TO REMOVE IMPROPER FINALITY OF OFFICE ACTION

Sir:

The Examiner issued a final Office action in the above-referenced application on May 8, 2002.

REMARKS

Applicants hereby request to have the finality of the rejection mailed on May 8, 2002 (Paper no. 9) removed as being premature. The Examiner has imposed a new ground of rejection that was neither necessitated by Applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p). See MPEP § 706.07(a). Applicants accordingly respectfully

request that the Primary Examiner reconsider the final rejection and withdraw the finality of the rejection pursuant to MPEP § 706.07(d).

In the OFFICE ACTION dated January 16, 2002 (Paper no. 4), the Examiner rejected claims 1-148 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent no. 5,878,223 issued to Becker et al. (the "Becker reference") in view of United States Patent no. 6,012,083 issued to Savitzky et al. (the "Savitzky reference"). Specifically, the Examiner alleged that the Becker reference teaches "a network," "using profiles to determine the content to send to a user," and "transmitting selected information." The Examiner further made a blanket allegation that the Becker reference teaches claims 1, 11, 25, 27, 28, 32-34, 44, 46, 56, 59, 65, 67-70, 73-74, 130-32, and 136-38 except for explicitly teaching a "user profile." The Examiner, however, never pointed out where either the Becker reference or the Savitzky reference teach or suggest a "hierarchical attribute value pair data structure." Under MPEP § 2143, the basic requirements of a *prima facie* case of obviousness, the Examiner must establish that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. Thus, the Examiner failed to establish a *prima facie* case of obviousness in the Office Action dated January 16, 2002 (Paper no. 4) because the Examiner failed to show that either the Becker reference or the Savitzky reference teach or suggest all the claim limitations.

Applicants responded to the rejection from Paper no. 4 in the RESPONSE TO OFFICE ACTION DATED JANUARY 16, 2002 (Paper no. 8) by canceling claims 142-48 and arguing that the cited references failed to teach or suggest a "hierarchical attribute value pair data structure," which was required in each of the remaining claims 1-141. See Paper no. 8, page 2, line 28 through page 3, line 20. Applicants did not amend claims 1-141. Thus, Applicants responded to the rejection by showing that the Examiner had failed to produce a *prima facie* case of obviousness with respect to each of the pending claims 1-141. Where the Examiner has failed

to produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. See MPEP § 2142.

In response to the Applicants' arguments showing that the Examiner failed to produce a *prima facie* case, the Examiner, *for the first time*, asserted that the "[t]he broad claim language is interpreted on its face and based on this interpretation the claims have been rejected," that the Becker reference "teaches a hierarchical attribute value pair data structure," and that the "feature calculator" disclosed in the Savitzky reference "also reads on a hierarchical attribute value pair data structure." See Paper no. 9, page 4, paragraph 14; page 3, paragraph 7, lines 4-5; and page 3, paragraph 7, lines 9-12, respectively. Thus, the Examiner is imposing a new ground of rejection in a final office action although the Applicants did not amend any of the pending claims.

Further, both references cited in the rejection under 35 U.S.C. § 103(a), i.e., the Becker reference and the Savitzky reference, were included on the Examiner's Notice of References Cited form included in the OFFICE ACTION dated January 16, 2002. Thus, the new grounds of rejection were not "based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p)."

Accordingly, the Examiner improperly issued a final rejection including a new grounds of rejection that was neither necessitated by Applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p). See MPEP § 706.07(a). Applicants

accordingly respectfully request that the Primary Examiner reconsider the final rejection and withdraw the finality of the rejection pursuant to MPEP § 706.07(d).


Dated this 8th day of July, 2002.

Respectfully submitted,



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PATENT TRADEMARK OFFICE



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